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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,400	10/07/2005	Tsutomu Kawakatsu	TOW-129US	9270

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EXAMINER
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MACARTHUR, VICTOR L

ART UNIT	PAPER NUMBER
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3679

MAIL DATE	DELIVERY MODE
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06/02/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/552,400	<b>Applicant(s)</b> KAWAKATSU ET AL.	
	<b>Examiner</b> VICTOR MACARTHUR	<b>Art Unit</b> 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,6-8 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) 2-5 and 9-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6-8 and 13-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 April 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/7/05, 8/28/07, 10/10/07</u> .                              | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election without traverse of Species 5, figure 8, claims 1, 6-8 and 13-17; in the reply filed on 4/10/2008 is acknowledged.

Claims 2-5 and 9-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4/10/2008.

### *Drawings*

The drawings were received on 4/10/2008. These drawings are acceptable for the purposes of examination.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 6-8 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, it is unclear if the applicant is claiming a finally assembled product wherein the limitation "wherein said plurality of rolling members are retained by paste wax which is adhered to inner diameter portions of said roller members **when said plurality of rolling members are installed** to said inner diameter portions of said roller members" is a mere

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product by process limitation (i.e., the final product does not contain paste wax, see applicant's specification p.34, ll.23-25) that does not limit the claim; or if the applicant intends to claim the intermediate product limited to positively require "paste wax" (emphasis added). For purposes of the current Office Action, the examiner assumes the final product since the term "when said plurality of rolling members are installed" is conditional and thus does not appear to structurally limit the claim.

Regarding claim 8, it is unclear whether applicant is claiming a product or method. If the limitation "wherein solid wax is melted and supplied in a liquid state to inner diameter portions of said roller members, and said plurality of rolling members are retained on said inner diameter portions of said roller members by said solid wax which is thereafter solidified" is meant to be a mere product by process limitation, then it must be amended accordingly.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1, 6-8 and 13-17 are rejected under 35 U.S.C. 103(a) as obvious over Goto (U.S. Patent 5,989,124) in view of Batt (U.S. Patent 3,239,291), Scriebner (U.S. Patent 1,982,932), and Swart (U.S. Patent 1,907,015).

Claims 1, 8 and 13-16. Goto discloses (figs.25-32) a constant velocity universal joint comprising a cylindrical outer member (1) which is connected to one transmission shaft and which is provided with a plurality of guide grooves (grooves in 1 receiving 72) separated from each other by predetermined distances and extending in an axial direction on an inner circumferential surface, and an inner member (4) which is inserted into an open inner space of said outer member and which is connected to the other transmission shaft, said constant velocity universal joint including: a plurality of trunnions (55) which are expanded toward said guide grooves; ring-shaped roller members (72) which contact said guide grooves and which are externally fitted to said trunnions; and a plurality of rolling members (6) which are interposed rollably between said trunnions and said roller members.

- The specific method of forming is not germane to the issue of patentability of the device itself. See MPEP § 2113. It is well established by case law that it is the patentability of the product that is to be determined even though such claims are limited and defined by process steps. See *In re Thorpe et al*, 227 USPQ 964 (CAFC 1985). Therefore, the limitation “wherein said plurality of rolling members are retained by paste wax which is adhered to inner diameter portions of said roller members **when said plurality of rolling members are installed** to said inner diameter portions of said roller members” (lines 12-14 of claim 1) has been given only limited patentable weight (emphasis added).
- However, for the sake of argument, if applicant intends to claim an intermediate product (see 112 rejections above) positively limited by “paste wax”, then it should be noted that each of Batt, Scriebner, and Swart teach that it is very desirable to use a

wax to hold rollers in place during assembly and then remove the wax to form the final product since such practice simplifies assembly. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Goto to use wax for the purpose of simplifying assembly.

Claim 6. The constant velocity universal joint according to claim 1, wherein said paste wax comprises an oil/fat component which has a consistency lower than that of a lubricating grease to be enclosed in said inner space portion of said outer member (in that the prior art wax structure is presumed to inherently have the applicant's claimed properties in accordance with MPEP 2112.01). Furthermore:

- Even if the prior art material did not inherently possess applicant's claimed properties, it appears that the claimed properties have no criticality. Wherein a specific limitation has no criticality, case law can be relied upon as the sole rationale in an obviousness rejection. See MPEP 2144.04. It has generally been recognized that selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Since the limitation has no criticality and has thus been established by the case law cited above to be an obvious design consideration within the skill of the art. "[T]he results of ordinary innovation are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the progress of useful arts. See U.S. Const., Art. I, section 8, cl.8." In re KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007).

Claim 7. The constant velocity universal joint according to claim 1, wherein a consistency of said paste wax, which is measured according to the Japanese Industrial Standard, is not less than 50 and less than 300, (in that the prior art wax structure is presumed to inherently have the applicant's claimed properties in accordance with MPEP 2112.01). Furthermore:

- Even if the prior art material did not inherently possess applicant's claimed properties, it appears that the claimed properties have no criticality. Wherein a specific limitation has no criticality, case law can be relied upon as the sole rationale in an obviousness rejection. See MPEP 2144.04. It has generally been recognized that selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Since the limitation has no criticality and has thus been established by the case law cited above to be an obvious design consideration within the skill of the art. "[T]he results of ordinary innovation are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the progress of useful arts. See U.S. Const., Art. I, section 8, cl.8." In re KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007).

Claim 17. The constant velocity universal joint according to claim 1, wherein each of said plurality of roller members comprises a first flange (flange of 72 above 6) and a second flange section (flange of 72 below 6) formed on said inner diameter portion thereof, said first flange section being separated from said second flange section in the axial direction of said trunnions by an annular recess section (recess of 72 receiving 6).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

June 3, 2008

/Victor MacArthur/  
Primary Examiner, Art Unit 3679